

REMARKS

In the Final Office Action, the Examiner rejected claims 1-10 and 33-37. By this Response, Applicant amends claims 1, 10, 11, 15, 18, 19, 26-27, 29, and 33, cancels claims 12, 13, and 35, and adds new claims 38-46. These amendments do not add new matter. In view of the foregoing amendments and following remarks, Applicant respectfully requests allowance of all pending claims.

Rejection Under 35 U.S.C. § 102

In the Final Office Action, the Examiner rejected claims 1-2, 4, 6-10, 33-34 and 36-37 as anticipated by Anderson (U.S. Patent No. 2,659,796). Applicant respectfully traverses this rejection.

Legal Precedent

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicant needs only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the identical invention "in as complete detail as contained in the ... claim" to support a prima facie case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Further, the pending claims must be given an interpretation that is reasonable and consistent with the *specification*. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q.

541, 550-51 (C.C.P.A. 1969) (emphasis added); M.P.E.P. §§ 608.01(o) and 2111. Indeed, the specification is "the primary basis for construing the claims." *See Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005) (*en banc*). One should rely *heavily* on the written description for guidance as to the meaning of the claims. *See Id.*

Interpretation of the claims must also be consistent with the interpretation that *one of ordinary skill in the art* would reach. *See In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. § 2111. "The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation." *See Collegenet, Inc. v. ApplyYourself, Inc.*, No. 04-1202, -1222, 1251, at 8-9 (Fed. Cir. August 2, 2005) (quoting *Phillips*, No. 03-1269, -1286, at 16). The Federal Circuit has made clear that derivation of a claim term must be based on "usage in the ordinary and accustomed meaning of the words amongst artisans of ordinary skill in the relevant art." *See Id.*

Claim 1 and its Dependent Claims

The Anderson reference is deficient for a number of reasons. For instance, the cited reference does not teach or suggest "a thermal storage member adapted to absorb heat from the torch head and subsequently return the heat to the welding implement," as recited by independent claim 1. (Emphasis added.) In contrast, the Anderson reference teaches a gas nozzle 4 with radiating fins 24, 25, and 26. Anderson, col. 3, ll. 66-69. "The concentric fins [24, 25 and 26] give a large surface area to radiate the heat and prevent overheating of the nozzle." *Id.* at col. 3, ll. 72-75 (emphasis added). As a result, the radiating fins 24, 25, and 26 discharge heat from the nozzle 4 and do not return heat to the nozzle 4. Thus, the Anderson reference could not possibly teach *all* of the features of claim 1. In view of these deficiencies, the cited reference cannot anticipate claim 1 or the claims that depend therefrom.

Claim 33 and its Dependent Claims

The Anderson reference is deficient for a number of reasons. For instance, the cited reference does not teach or suggest a "metallic member [that] is configured to absorb heat from the conductor and subsequently return the heat to the conductor," as recited by independent claim 33. (Emphasis added.) In contrast, as noted above, the Anderson reference teaches a gas nozzle 4 with radiating fins 24, 25, and 26. These radiating fins 24, 25, and 26 expel heat from the nozzle 4 into the atmosphere rather than return heat to the nozzle 4. *See, Id.* Indeed, during normal operation, it appears that the radiating fins 24, 25, and 26 would be cooler than the nozzle 4, thereby rendering them incapable of returning heat to the nozzle 4, as recited by claim 33. Thus, the Anderson reference could not possibly teach *all* of the features of claim 33. In view of these deficiencies, the cited reference cannot anticipate claim 33 or the claims that depend therefrom.

For these reasons among others, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 102.

Rejection Under 35 U.S.C. § 103

In the Final Office Action, the Examiner rejected claims 3 and 35 as obvious over Anderson (U.S. Patent No. 2,659,796). Applicant respectfully traverses this rejection.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the

desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been "well within the ordinary skill of the art" based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Claim 3

Claim 3 depends from claim 1. The rejection of claim 3 under Section 103 is defective for at least the reasons set forth above with respect to the rejection of claim 1 under Section 102. Particularly, the Anderson reference does not disclose or suggest "a thermal storage member adapted to absorb heat from the torch head and subsequently return the heat to the torch head," as recited by claim 1. As noted above, the Anderson reference discloses a gas nozzle 4 with heat radiating fins 24, 25, and 26 that radiate heat from the gas nozzle 4 into the atmosphere. Thus, the radiating fins 24, 25, and 26 are not adapted to return heat to the gas nozzle 4. Indeed, the radiating fins 24, 25, and 26 are designed "with a large surface area" to prevent them from storing heat that might be returned to the nozzle 4. *See id* at col. 3, ll. 72-75. Accordingly, the Anderson reference, taken as it stands or hypothetically modified, cannot render claim 3 obvious.

Claim 35

Claim 35 depends from claim 33. The rejection of claim 35 under Section 103 is defective for at least the reasons set forth above with respect to the rejection of claim 35 under Section 102. Specifically, the Anderson reference does not disclose or suggest “a metallic conductor [that] is configured to absorb heat from the conductor and subsequently return heat to the conductor,” as recited by independent claim 33. (Emphasis added). As discussed above, the Anderson reference discloses a gas nozzle 4 with heat radiating fins 24, 25, and 26 that discharge heat into the atmosphere rather than return heat to the gas nozzle 4. Accordingly, the Anderson reference, taken as it stands or hypothetically modified, cannot render claim 35 obvious.

For these reasons among others, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 103.

New Claims

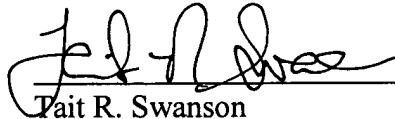
As noted above, the Applicant hereby adds new claims 38-46, including new independent claim 45. The Applicant submits that claims 38-44 depend from independent claims 1 and 33 and, thus, are believed to be allowable for the reasons discussed above and also by virtue of the features recited in each respective claim. Regarding independent claim 45, the Applicant stresses that the Anderson reference does not disclose or suggest a “protective cover substantially enveloping the thermal storage member.” Thus, Applicant believes claim 45 and dependent claim 46 to be allowable. For at least these reasons, the Applicant respectfully requests allowance of new claims 38-46.

Conclusion

Applicant respectfully submits that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: March 9, 2006

A handwritten signature in black ink, appearing to read 'Tait R. Swanson', is written over a horizontal line.

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